

35 U.S.C. § 103(a) as unpatentable over German Patent 1,018,209 (“Gabrielsson et al.”). Applicants respectfully submit that Gabrielsson et al. do not render obvious claims 1, 2, 5, 6, 8, 9 and 11 to 21 for the following reasons.

Claim 1 relates to a floor covering. Claim 1 comprises an elastomer material having a relief-type patterned surface, wherein the surface (2) is provided with irregularly distributed indentations (3), which have an elongated shape, which partially contact or intersect each other, and which have a depth (T) of 0.02 mm to 0.2 mm, at a width (B) of 0.2 mm to 2.5 mm and a length (L) of 5 mm to 50 mm. Claim 1 also recites that at least one end (6) of the indentations (3) is configured so as to run to a point.

Gabrielsson et al. allegedly relate to a floor wear layer which is made of plastic for sports halls. Gabrielsson et al. do not disclose or suggest the features of claim 1. Gabrielsson et al. merely provide squares (1), edged at each of four crossing locations by grooves or similar depressions which have curved side contours facing inwards (such as towards the center of gravity of the squares). The depth of the grooves varies between approximately 0.1 and approximately 2 mm. As provided in Figure 1, the squares (1), the curved side contours (2) and the depressions (3) are all placed in a regular patterned format. Gabrielsson et al. always provide a repeating pattern of squares separated on one axis by depressions (3). Figures 2, 3 and 4 also illustrate a regular repeating pattern. As a result, Gabrielsson et al. provide a regular repeating pattern and not an irregular distribution of indentations as required in claim 1. For this reason alone, Gabrielsson et al. do not disclose or suggest the features of claim 1.

Gabrielsson et al. describe that the prime objective of the invention is the “increase of frictional resistance and for the cushioning of the floor”. Claim 1. Contrary to the Gabrielsson et al. objective, however, the current application recites that the object of the invention is to “provide a floor covering which is very durable, easy to clean, as little roll-resistant as possible, and not greatly subject to wear and tear.” The Office Action admits that Gabrielsson et al. do not disclose or suggest indentations having a depth of 0.025 mm to 0.05 mm, a width of 0.2 mm to 2.5 mm and 0.4 mm to 1.3 mm, a length of 5 mm to 50 mm and 6 mm to 40 mm and the floor covering having a thickness of 2 mm to 5 mm and 2.5 mm to 4 mm. As Gabrielsson et al. seek to **encourage** frictional resistance and the current application seeks to limit roll-resistance, a person of ordinary skill in the art would not

modify Gabrielson et al. to provide any configuration resembling the configuration provided in the current application as Gabrielson et al. and the current application seek vastly different results. Applicants respectfully traverse the Final Office Action statement that a person of ordinary skill in the art would modify Gabrielson et al. to provide the features of claim 1 of the current application, as the objectives of the Gabrielson et al. reference is different than the current application.

Applicants respectfully submit that Applicants have specifically provided that the claimed configurations provide unexpected results, wherein the present invention has an improved rolling resistance coefficient of friction compared to standard nap surfaces. A significant decrease in startup and rolling resistances is provided. The present invention also provides a structure that is highly scuff resistant and which is easy to clean, while maintaining a significantly reduced rolling resistance, features that have not been present in one product to date.

Applicants furthermore respectfully submit that Gabrielson et al. do not disclose or suggest any configuration where at least one end of the indentations is configured to run to a point. Gabrielson et al. do not disclose or suggest any such configuration, rather Gabrielson et al. merely provide a repeating pattern of lines.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of references does not disclose, or even suggest, all of the limitations of claim 1. It is therefore respectfully submitted that the combination of references does not render obvious claim 1.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having

ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” -- which is not the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

In view of the foregoing, it is respectfully submitted that the combination of the references does not render obvious claim 1.

Claims 2, 5, 6, 8, 9 and 11 to 21 ultimately depend from claim 1 and therefore include all of the features of claim 1. Applicants respectfully submit that claims 2, 5, 6, 8, 9 and 11 to 21 are patentable for at least the reasons presented in relation to claim 1. Applicants respectfully request withdrawal of the rejections to claims 2, 5, 6, 8, 9 and 11 to 21.